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REMARKS

Status Summary

Claims 1-38 are pending in the present application, of which claims 1, 18, 35 and 37 are presented in independent form. No Claims have been allowed and claims 1-38 stand rejected. Claims 1-10 and 18-27 have been amended. The claims have been amended merely to address informalities. Specifically, the claims have been amended to remove identifiers of the recitations in the respective claims. Thus, these amendments were made for reasons unrelated to the statutory requirements for a patent and have not narrowed the scope of the claims.

Accordingly, the amendment of these claims does not raise any presumptions regarding, nor trigger the application of the doctrine of prosecution history estoppel to limit the range of equivalents. Further, any new ground of rejection can not be said to be necessitated by applicant's amendment.

Specification

The specification has been objected to "as failing to provide antecedent basis for the term computer readable medium."

The Office contends that the Specification fails to provide antecedent basis for the term "computer readable medium" The term "computer-readable medium" is a well known term in this art that refers to any medium that can contain, store, communicate, propagate, or transport instructions for use by or in connection with an instruction execution system, apparatus, machine, or device. The computer-readable medium can be, for example but is not limited to, an electronic, magnetic, optical, electromagnetic, or semiconductor system, apparatus, device, or propagation medium.

As such, Applicant respectfully submits that claims 18-34 are supported by the application as filed and thus satisfy the requirements of 37 CFR 1.75(d)(1) and MPEP 608.01(o).

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Claim Rejection(s) - 35 U.S.C. § 102

Claims 1-38 stand rejected as anticipated by U.S. Patent No. 6,073,142 to Geiger, et al. (hereinafter "Geiger").

To support a rejection under 35 U.S.C. § 102, each and every feature of the claimed invention must be shown in a single prior art document. In re Paulsen, 30 F.3d 1475 (Fed. Cir. 1994); In re Robertson, 169 F.3d 743 (Fed. Cir. 1999). The pending claims positively recite limitations that are not disclosed (nor suggested) in the cited document.

Specifically, claim 1 includes a recitation directed to "if the electronic message matches the criteria, displaying a graphic associated with the action when the electronic message is viewed at the client and executing the action if the graphic is selected." Geiger fails to disclose or even suggest such a recitation.

The Office contends that Geiger discloses the above referenced recitation. Specifically, the Action states:

> if the electronic message matches the criteria, displaying a graphic associated ["graphic buttons"] with the action when the electronic message is viewed at the client and executing the action if the graphic ["graphics can be a plurality of buttons displayed as part of the electronic message", specification page 7 such as action buttons at GUI] is selected (Figures 19-20 is a screen shot of graphical user interface of action gatekeeper that shows graphic buttons and rules status [filtering status] for each message, see Figure 19-20, blocks 1907,1909,1911,1913,1915 are graphic buttons associated with business rules , column 23, lines 5-36).

The cited sections of Geiger fail to disclose or suggest the above referenced recitation. The Office relies on the business rules disclosed in Geiger as anticipating the filter recitation of the instant claim. Specifically, the business rules in Geiger are direct to gating. Geiger teaches "gating" (C7:9-13, C7:44-47) where one of the automatic actions is to send the mail for review to an administrator who is NOT the recipient.

The administrator can access the "gated" mail via an administrator client illustrated in Figure 19 and described in Column 9 lines 42-43, Column 10 lines 54-55,

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and Column 23 lines 58-60. The administrator can perform a fixed set of actions as indicated by the buttons available in the sample screen for each message that is gated. The buttons are static buttons that are presented every time the sample screen in Figure 19 is presented. There is simply no teaching or suggestion in Geiger that the display of the buttons is in any way related to matching a filter. Use of the buttons is at the discretion of the reviewer/administrator, and the buttons available are always present.

The graphic buttons in Geiger are displayed independent of the business rules disclosed in Geiger. For example, button 1907 is a review button. The review button merely allows a message to be reviewed in a screen illustrated in Figure 20. The review button itself is not presented if the electronic message meets the criteria. Rather, this button is presented each time the sample screen illustrated in Figure 19 is shown. Similarly, the release button 1909 is always presented, and not presented if the electronic message meets the criteria. The return, forward, and file buttons (1911, 1913, and 1915) each provide traditional electronic message functions and are similarly always presented. Specifically Geiger states:

> FIG. 19 illustrates a sample user interface of the GKI 107, the main gatekeeper screen 1901. When a gatekeeper logs into a GPO 106, she identifies which gatekeeper role she has; the GKI 107 then displays in the gatekeeper screen 1901 the messages 1916 that have been gated to that gatekeeper.

It is clear from this section that the gatekeeper screen 1901 is displayed when the gatekeeper logs on. The gatekeeper screen 1901 displayed includes the buttons discussed above. As the buttons are displayed as part of gatekeeper screen 1901 at log on, the buttons can not said to be displayed if the electronic message matches the criteria. As such, Geiger cannot be said to disclose "if the electronic message matches the criteria, displaying a graphic associated with the action when the electronic message is viewed at the client and executing the action if the graphic is selected" as recited in claim 1.

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Further, claim 1 includes a recitation directed to displaying the graphic "when the electronic message is viewed at the client." Another recitation in claim 1 is directed to "receiving an electronic message for a client." The client receiving the electronic message is the antecedent basis for the client discussed in the recitation above. Accordingly, the client is the receiver of the message. As such, the above recitation is directed to displaying the graphic with the receiver of the message receives the message.

In contrast, there is no mention in Geiger of the client viewing the electronic message. Geiger illustrates an administrator client for a gatekeeper managing the message. The gatekeeper is not the receiver of the message. As discussed above, the buttons included in the gatekeeper screen that are cited as anticipating the above referenced recitation are displayed in response to a gatekeeper logging on. The buttons are not displayed when the electronic message is received by the client. This is clear in that the buttons in the gatekeeper screen are all for performing actions prior to the client receiving the message. That is, the buttons are associated with actions that either provide the client with the message or prevent the client from receiving the message. If the buttons discussed above all perform actions prior to the client receiving the message, the buttons cannot be displayed "when the electronic message is viewed at the client." As such, Geiger cannot be said to disclose "if the electronic message matches the criteria, displaying a graphic associated with the action when the electronic message is viewed at the client and executing the action if the graphic is selected" as recited in claim 1.

Accordingly, since Geiger fails to disclose each and every feature of the claimed invention for at least the above reasons, claim 1 is not anticipated by Geiger. The Action states that claim 18 is a computer readable medium claim of method claim 1, and claims 35 and 37 system claims of claim 1. Accordingly, claims 18, 35 and 37 contain analogous recitations to those discussed above and are allowable for at least the same

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reasons. Furthermore, rejected claims 2-17, 19-34, 36, and 38 are novel and inventive for at least the same reasons.

As stated above, claims 3-5, 7-9, 11-12, and 14 are allowable for at least the same reasons stated above. Further, each of these claims contains additional recitations that are not disclosed or suggested by Geiger. Specifically, claim 3 includes a recitation directed to "placing the electronic message with the action list in the recipient's inbox." The action cites Column 19, line 52 - column 21 line 24 of Geiger as anticipating this recitation. Applicant has reviewed Geiger and can find no reference in the cited section (or any other section for that matter) to "placing the electronic message with the action list in the recipient's inbox." As stated above, Geiger deals with an administrator GUI and does not discuss a recipient inbox in any manner. If the Examiner disagrees, the Examiner is requested to point out particularly where this feature is disclosed or suggested in the cited document..

Further, claims 4 and 5 include recitations directed to "inserting computer code into the electronic message if the electronic message matches the criteria" and to "inserting a graphic associated with each action in the action list into the electronic message" respectively. There is no teaching or suggestion in Geiger of inserting code or a graphic into the message or the action list. The action cites "Figure 19-20, blocks 1907, 1909,1 911 ,1913, 1915 are graphic buttons, column 23, lines 5-36" and " column 1, line 35 - column 2, line 14" of Geiger as anticipating these recitations. Applicant has reviewed Geiger and can find no reference in the cited section (or any other section for that matter) to "inserting computer code into the electronic message" or "inserting a graphic associated with each action in the action list into the electronic message." There is simply no discussion in Geiger of inserting computer code into a message or a graphic into an action list. If the Examiner disagrees, the Examiner is requested to point out particularly where this feature is disclosed or suggested in the cited document.

Claims 7-9 and 14 each include recitations directed to actions taken at the client. The Action cites column 21, line 26 - column 22 line 10 and column 23, lines 5-36 as

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anticipating the recitations included in claims 7-9. As discussed above, the actions taken in Geiger .are all taken at the server by a gatekeeper. Applicant has reviewed Geiger and can find no reference in the cited section (or any other section for that matter) to actions taken on the client. There is no reference to actions taken at the client that receives the message. If the Examiner disagrees, the Examiner is requested to point out particularly where this feature is disclosed or suggested in the cited document.

Claims 11-12 include recitations directed to "the criteria of the filter are customizable for a recipient" and "the action is customizable for a recipient." The Action cites "Figure 4B, for automatic and manual review with Figures 6-8 that shows different options to configure filters and rules" as anticipating the recitations described above. Applicant has reviewed Geiger and can find no reference in the cited Figures (or any other Figure or section for that matter) to criteria or actions customizable for a recipient. There is no reference to any recipient based customization. Figures 4B and 6-7 all describe actions and criteria that are based on the gatekeeper role and not the recipient. Figure 8 shows a GUI for creating rules based on message properties such as size and attachment size. There is simply no disclosure or suggestion of recipient based customization of criteria of the filter or of an action in Geiger. If the Examiner disagrees, the Examiner is requested to point out particularly where this feature is disclosed or suggested in the cited document.

Accordingly, since Geiger fails to disclose each and every feature of the claims for at least the above reasons as well, claims 3-5, 7-9, and 11-12 are not anticipated by Geiger.

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CONCLUSION

In view of the above, it is respectfully submitted that the present application is now in proper condition for allowance, and an early notice to such effect is earnestly solicited. The Examiner is respectfully requested to telephone the undersigned patent attorney at the below-listed number if, after reviewing the above Remarks, the Examiner believes outstanding matters remain that may be resolved without the issuance of a subsequent Official Action.

DEPOSIT ACCOUNT

The Commissioner is hereby authorized to charge any additional fees, or credit any overpayment, associated with the filing of this paper to Deposit Account No. **50-3512**.

Respectfully submitted,

Date: <u>January 9, 2008</u>   <u>/John A. Demos/</u>

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